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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/466,124	12/21/1999	MITCH A. BRISEBOIS	71493-591	9802
7590 04/19/2006				
SMART & BIGGAR PO BOX 2999 STATION D 900-55 METCALFE STREET OTTAWA, K1P5Y6 CANADA			EXAMINER HOM, SHICK C	
			ART UNIT 2616	PAPER NUMBER

DATE MAILED: 04/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/466,124

Applicant(s)

BRISEBOIS ET AL.

Examiner

Shick C. Hom

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,8,11,12,21-23,26-28,30,31,36,39,40 and 43 is/are rejected.
- 7) ☒ Claim(s) 3,4,6,7,9,10,13-20,24,25,29,32-35,37,38,41,42 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 1/27/06 have been fully considered but they are not persuasive.

In response to applicant's argument in page 15, page 17 lines 8-23, and page 18 line 16 to page 19 line 11, that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that the MSC, BSC or BTS having all of the "means for grouping," "means for determining," and "means for enabling communication" and the intelligent peripheral of claim 26 being a server designed to control service features that are available to the mobile station within the cell cluster and which maintains a registry of all the mobile stations assigned to the MSC 20 by maintaining a database with all their HLRs) are not recited in the rejected claim(s); the claims recite merely an apparatus comprising these means. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In page 16 and page 17 lines 1-7, applicant argued that the group call traffic channel is not the same as the respective

Art Unit: 2616

maintained communication link is not persuasive because a maintained communication link is merely a preserved or sustained link, i.e. a link that is keep in working condition; any working communication link would be a maintained communication link.

In response to applicant's argument in page 19 line 12 to page 21 that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one of ordinary skill in the art would be motivated to connect a personal computer having a wireless modem of Hamalainen et al. to the wireless network of Amirijoo et al. because it would provide the desirable added feature of data communication to the wireless network of Amirijoo et al.

Art Unit: 2616

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 2, 5, 8, 11, 12, 21, 22, 23, 27, 28, 30, 36, 39, 40, 43 are rejected under 35 U.S.C. 102(e) as being anticipated by Amirijoo et al. (6,405,050).

Regarding claims 1, 11, 12, 22, 28, 36, 40:

Amirijoo et al. disclose an apparatus for controlling data unit communications between a plurality of mobile stations, each of the mobile stations having a respective maintained communication link with the apparatus (see col. 5 lines 11-18 which recite the notification message being continuously transmitted to the mobile stations in the group clearly anticipate the mobile stations having a maintained communication link), the apparatus comprising: means for grouping at least two of the plurality of mobile stations as members of a private

Art Unit: 2616

network group (see col. 3 lines 49-57 which recite means for adding "group call" as an additional subscriber service to an existing cellular network wherein member of a predefined group can set up call to each member of the group such as a law enforcement dispatcher notifying law enforcement personnel of emergency using a group call where the dispatcher and personnel are members of the common group clearly anticipate means for grouping); means for determining if a first mobile station sending a data unit and a second mobile station scheduled to receive the data unit are both members of the private network group (see col. 6 lines 49-60 which recite the step of determining whether the receiving mobile station belongs to the same group as that of the sending station clearly anticipate means for determining members of the group); and means for enabling communication of the data unit from the first mobile station to the second mobile station through the respective maintained communication links of the first mobile station and the second mobile station only if they are both members of the private network group (see col. 2 lines 24-35 which recite the mobile station receiving a group call including a notification message having a group identification number and counter on a control channel clearly reads on means for enabling

Art Unit: 2616

communication through the maintained communication links if the first and second station are both members of the network group).

Regarding claims 2, 5, 23:

Amirijoo et al. disclose wherein each of the mobile stations has a corresponding Home Location Registration (HLR); wherein the means for grouping at least two of the plurality of mobile stations as members of a private network group comprises means for listing the HLRs of the at least two mobile stations within a private network group table; and wherein the means for determining if the first and second mobile stations are both members of the private network group comprises means for determining if the HLRs of the first and second mobile stations are both listed within the private network group table (see col. 3 lines 26-57 and col. 5 line 66 to col. 6 line 9 which recite the Home Location register HLR, a database maintaining all subscriber information and the Visitor Location Register VLR containing information about the mobile stations currently located within the MSC/VLR area and technique of setting up subscriber groups using the stored information to determine whether the mobile stations are within the network group).

Regarding claims 8, 21, 39, 43:

Amirijoo et al. disclose further comprising means for determining if the data unit is of a type requiring limited

Art Unit: 2616

access, and means for enabling communication of the data unit from the first mobile station to the second mobile station if the data unit is not of the type requiring limited access, even if the first and second mobile stations are not both members of the private network group (see col. 3 line 58 to col. 4 line 4 which recite means for reaching only members of the group within a certain area using the "group call area" whereby members outside the group call area are not called clearly anticipate the means for determining the limited access type communication as claimed).

Regarding claims 27, 30:

Amirijoo et al. disclose wherein at least one of the plurality of apparatus is a server coupled to a Local Area Network (LAN) and further comprising a mobile switching center coupled between the apparatus and the radio network controller, the mobile switching center comprising means for controlling the switching operations of the wireless network within a predefined cell cluster (see Fig. 1 and col. 2 line 66 to col. 3 line 25 which recite the Mobile services Center and the subscriber network clearly reads on the server and LAN, respectively).

Art Unit: 2616

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Amirijoo et al. (6,405,0500) in view of Fraccaroli (6,549,768).

Art Unit: 2616

Regarding claim 26:

For claim 26, Amirijoo et al. disclose the wireless network described in paragraph 3 of this office action. Amirijoo et al. disclose all the subject matter of the claimed invention with the exception of wherein at least one of the plurality of apparatus is an intelligent peripheral coupled within a third generation wireless network.

Fraccaroli from the same or similar fields of endeavor teach that it is known to provide wherein at least one of the plurality of apparatus is an intelligent peripheral coupled within a third generation wireless network (see col. 6 lines 45-59 which recite use of the third generation wireless handsets). Thus, it would have been obvious to the person having ordinary skill in the art at the time the invention was made to provide wherein at least one of the plurality of apparatus is an intelligent peripheral coupled within a third generation wireless network as taught by Fraccaroli in the apparatus for group calls of Amirijoo et al. The means wherein at least one of the plurality of apparatus is an intelligent peripheral coupled within a third generation wireless network can be implemented by providing the mobile communications system including the use of the third generation wireless network of Fraccaroli into the controller Amirijoo et al. The motivation

Art Unit: 2616

for using wherein at least one of the plurality of apparatus being an intelligent peripheral coupled within a third generation wireless network as taught by Fraccaroli in the apparatus for grouping calls of Amirijoo et al. being that it provides the added feature of using third generation wireless network.

7. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Amirijoo et al. (6,405,050) in view of Hamalainen et al. (6,249,584).

Regarding claim 31:

For claim 31, Amirijoo et al. disclose the wireless network described in paragraph 3 of this office action. Amirijoo et al. disclose all the subject matter of the claimed invention with the exception of wherein at least one of the mobile stations comprises a personal computer with a wireless modem.

Hamalainen et al. from the same or similar fields of endeavor teach that it is known to provide at least one of the mobile stations comprising a personal computer with a wireless modem (see col. 6 lines 24-60). Thus, it would have been obvious to the person having ordinary skill in the art at the time the invention was made to provide at least one of the

Art Unit: 2616

mobile stations comprising a personal computer with a wireless modem as taught by Hamalainen et al. in the wireless network of Amirijoo et al. The at least one of the mobile stations comprising a personal computer with a wireless modem can be implemented by connecting the personal computer with a wireless modem of Hamalainen et al. in the mobile station of Amirijoo et al. The motivation for providing at least one of the mobile stations comprising a personal computer with a wireless modem as taught by Hamalainen et al. in the wireless network of Amirijoo et al. being that it provides the added feature of connecting a personal computer or data terminal into the wireless network of Amirijoo et al.

Allowable Subject Matter

8. Claims 3-4, 6-7, 9-10, 13-20, 24, 25, 29, 32-35, 37-38, and 41-42 would be allowable if rewritten to include all of the limitations of the base claim and any intervening claims.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this

Art Unit: 2616

action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shick C. Hom whose telephone number is 571-272-3173. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema Rao can be reached on 571-272-3174. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2616

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SH

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